



Patent

In re application of

Examiner Fox

Group Art Unit 3652

For: **LINER FOR CONTAINER
WITH SIDE DOOR**

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FEB 06 2003
GROUP 3600

Assistant Commissioner
for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated October 29, 2002, the rejection of claims 1, 2, 4-6, 9 and 10 as being "obvious" in view of U.S. Patent No. 3,951,284 to Fell is respectfully traversed without amendment.

As emphasized in the response made to the first Office Action and now reiterated, claim 1 expressly requires a moisture proof liner for an elongated container for use in shipping cargo comprising four elongated panels of impervious film adapted to substantially match the elongated sides, top and bottom of the container and first and second end panels to complete the liner. An access opening is provided along at least one side panel for loading and unloading cargo, and a closure seals the liner against moisture to protect the cargo. As explained in detail in the Background of the Invention section of Applicant's

specification, the need met by the present invention is “providing a system for cargo shipping containers, characterized by a side, rather than end door for transfer of the cargo into and out of the container.” Method claim 9 requires, *inter alia*, the steps of “providing . . . [a] liner having four elongated panels” including for covering the sides, top, and bottom of . . . [a] container” and “cutting an access opening along at least one side panel.”

The inventions recited in claims 1 and 9 are in stark and total contrast to the liner disclosed in the Fell ‘284 patent, which as admitted by the Examiner simply does not teach a liner having an opening on a side panel corresponding to the top, bottom, or side of an elongated container. Rather, it shows the conventional opening formed in the end panel of the liner, which obviously would not meet the need identified by the Applicant and fulfilled by the inventions of claims 1 and 9. Accordingly, since these claims clearly distinguish between the end panels and the side panels and plainly describe the location of the opening, it is believed that the ‘284 patent does not suggest the inventions claimed therein. Since no other evidence is cited as allegedly supplying the teaching missing from this reference or suggesting this modification, it is believed that the *prima facie* case of obviousness is lacking. See Manual of Patent Examining Procedure § 2143.03 (stating that “[t]o establish *prima facie* obviousness of a claimed invention, ***all claim limitations must be taught or suggested by the prior art***”) (emphasis added) (citations omitted).

Precedential decisions of the Court of Appeals for the Federal Circuit fully support

Applicant's position in this regard. For example, in the decision of In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), the Federal Circuit overturned an Examiner's determination regarding the obviousness of a claimed invention. In the course of doing so, it explained that:

[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. ***Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.***

Id. at 1784 (emphasis added). The highlighted point was further emphasized in the more recent decision of *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), in which the court held that the Board of Patent Appeals and Interferences improperly relied upon "common knowledge and common sense" of a person of ordinary skill in the art to find invention of patent application obvious. Instead, the court emphasized the need for "**objective evidence**" on this point, as opposed to subjective speculation.

Here, not even a scintilla of objective evidence is produced indicating that anything in the prior art "suggested" the proposed modification to the liner disclosed in the Fell et al. patent. Indeed, while it is easy for the Examiner to conclude subjectively that the invention of claim 1 is "obvious," ostensibly because it is not terribly complex technology, the position

advanced fails to consider that the only suggestion in Fell et al. is to provide a liner with an opening in an end panel of a liner. While the end opening admittedly corresponds to the door of the container, this does not fairly support the conclusion that it would thus be “obvious” to provide the opening in a different side panel of the liner, merely to accommodate a door in a type of container that is not even disclosed in the reference. This is simply speculation on the part of the Examiner based on hindsight using the Applicant’s teaching as a blueprint, which is of course never proper. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation” to make a modification as an “essential evidentiary component of an obviousness holding”); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”).

Applicant concedes that the Fell et al. patent “suggests” and, in fact, expressly discloses providing an opening in an end panel of a liner. However, if the liner with the opening in the end panel disclosed in the Fell et al. patent were simply used in an elongated container with a side door, ***it would not work!*** This is because the liner disclosed in this patent includes elongated sides and short ends, and it is one of the short ends that includes

the "access" opening. If such a liner were inserted in a container with a side door, the elongated side panels would face the short ends of the container when erected, and thus would not match (as required in both claims 1 and 9). Moreover, these elongated sides could not be moved into contact with the ends of the container in an easy and efficient manner, such as by using positive or negative air pressure. Instead, some deformation or stretching of these panels would be required to make the rearrangement, which is not only extraordinarily difficult to accomplish, but also deleteriously risks perforating the liner. Since a moisture-proof liner is required, this would essentially render it ineffective for its intended purpose.

Also, if a second access opening were added to the elongated side panel of the Fell et al. liner to accommodate a container with a side door, the Office Action fails to explain how one would deal with the openings on the end panel, which would ostensibly face a side wall of the container and would be rendered useless. If the position is that the end openings would simply be moved to the side, then this modification defeats the purpose of the invention shown in the '284 patent, which is a liner for a container having a door at an end, rather than along the side. Even if this patent is considered to disclose that the opening is provided adjacent to a door in the container, this cannot be considered *per se* to teach or suggest what is now being claimed: a liner with an elongated side having an access opening, which is intended for use in a container having a side door, when in fact there is nothing in

the reference to suggest such an arrangement.

Simply put, the Fell et al. patent does not even contemplate providing an access opening in an elongated side panel of a liner, as opposed to the end panel. Rather, like all cited prior art, it simply discloses the conventional access opening in the end panel. As explained above, the two liners are not interchangeable, and no prior art arising in the nearly 30 years since the application that matured into the Fell et al. patent is identified that suggests the modification made by the present Applicant or a corresponding method of use, as now embodied in claims 1 and 9 of the patent. This belies the Examiner's position that it would have been "obvious" to simply place the opening at the location corresponding to the door in the container, which is based on subjective speculation alone, rather than the "objective" evidence that the precedential case decisions expressly require. Consequently, it is believed that claims 1 and 9 are directed to patentable subject matter over the sole piece of prior art cited against it by the Examiner.

The rejections of the several of the dependent claims must also fail for similar reasons. For example, claim 5 requires that the opening is along the mid-point of one of the elongated side panels. Since the Fell et al. patent does not even teach providing such an opening in a side panel, it certainly cannot teach or suggest providing it at a mid-point of the panel. Moreover, even if the opening in the liner disclosed in the Fell et al. patent were provided at the mid-point of the end panel, it is emphasized that this liner would not work

in a container with a side door, since the elongated sides of that liner would not “substantially” match the corresponding sides of the container.

As for claim 6, the Examiner contends that the Fell et al. patent teaches “access openings for containers having openings on one or more sides depending on the configuration of the container,” but cites to no portion of the document as supplying this teaching. Applicant’s Counsel has scoured this reference, but finds that it is limited to providing one or more access openings on a *single end panel* of a liner. It simply does not contemplate providing openings in a second side panel substantially opposite the first opening, as expressly required by the claim. This is because the Fell et al. liner is for use on a trailer or other container including doors on only a single end. Thus, it certainly cannot “suggest” this modification, and no other convincing line of reasoning is provided as to why a skilled artisan would want to provide a second opening at the opposite end of the liner disclosed in Fell et al., when the opening would simply face the end wall of the trailer near the cab, which is *always* closed.

The Examiner also contends that it would have been obvious to provide the liner with gussets, as required in claim 7, or to perform the holding step of claim 11. However, it is conceded that the Fell et al. patent does not disclose, teach, or suggest these limitations, and not a shred of evidence is cited as supporting the proposition that the prior art otherwise “suggests” using them in a liner having an opening in an elongated side panel. The Derby

et al. patent is inapposite, since it discloses a completely different type of liner. Consequently, it is believed that the *prima facie* case of obviousness is lacking with respect to these claims as well.

In summary, Applicant has addressed all issues raised in the Office Action. In particular, the manner in which claims 1 and 9 patentably distinguishes over the '284 patent has been explained convincingly and in detail. The independent patentability of several of the dependent claims is also established. Since all claims are believed to be in condition for allowance, an early notice to this effect is earnestly solicited. However, if the Examiner finds that some minor issue has been overlooked, he is encouraged to contact the Applicant's Counsel at the number listed below in order to reduce costs and expedite the issuance of this patent. Also, any fees due for processing this response may be debited from Deposit Account 11-0978.

Respectfully submitted,

KING & SCHICKLI, PLLC

A handwritten signature in black ink, appearing to read 'Andrew D. Dorisio', with a horizontal line extending to the right.

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Date 1-29-03 L Williams